

Notice of Allowability

Application No.

10/009,315

Examiner

Diana B. Johannsen

Applicant(s)

CHALKER ET AL.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Amendment filed 26 February 2004 and the interview concluding 8 April 2004.
2. ☒ The allowed claim(s) is/are 28 and 29.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>part of 0404</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

EXAMINER'S AMENDMENT

1. This action is in response to the Amendment filed February 26, 2004 and to the interview concluding April 8, 2004. Claims 1-27 and 30-32 were canceled by the Amendment of February 26, 2004; accordingly, rejections of those claims set forth in the Office action of August 26, 2003 are moot. The remaining rejections set forth in the Office action of August 26, 2003 are withdrawn in view of the Amendment filed February 26, 2004 and further in view of the below examiner's amendment. Claims 28-29 are now allowed.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jason C. Fedon on April 8, 2004.

2. In accordance with 37 C.F.R. 1.126, allowed claims 28-29 will be renumbered as claims 1-2, respectively (see MPEP 608.01(j)). It is noted that original claim numbers are employed in the below examiner's amendment.

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3. The application has been amended as follows:

a) Amend the claims as follows:

In claim 28, lines 10-11, after "the first strand" insert—of said cassette--.

In claim 28, line 18, after "region" insert--, thereby producing amplified first and second regions--.

In claim 28, line 19, after "regions" insert--, thereby producing a mixture--.

In claim 28, line 22, after "second region of DNA" delete "sequence" and insert therefore—sequences--.

In claim 28, line 22, after "wherein" insert—said--.

In claim 28, line 27, after "cooling the" delete "heated".

In claim 28, line 28, after "the mixture" insert—of (ii)--.

In claim 28, line 29, after "the mixture" insert—of (iii)--.

In claim 28, lines 30-31, after "the mixture" insert—of (iv)--.

In claim 28, line 32, after "the mixture" insert—of (v)--.

In claim 28, line 33, after "the mixture" insert—of (vi)--.

In claim 28, line 33, after "primer P1" insert—complementary to said first region--.

In claim 28, line 34, after "primer P4" delete "for the nucleotide sequence region downstream of the target site" and insert therefore—complementary to said second region--.

In claim 29, line 8, after "the first strand" insert—of said cassette--.

In claim 29, line 10, after "the second region" insert--, thereby producing a mixture--.

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In claim 29, line 14, after "cooling the" delete "heated".

In claim 29, line 16, after "the mixture" insert—of (d)--.

In claim 29, line 18, after "the mixture" insert—of (e)--.

In claim 29, line 20, after "the mixture" insert—of (f)--.

In claim 29, line 21, after "the mixture" insert—of (g)--.

In claim 29, line 22, after "the mixture" insert—of (h)--.

In claim 29, line 23, after "P1" delete "for" and insert therefore—complementary to--.

In claim 29, line 23, after "P4" delete "for" and insert therefore—complementary to--.

In claim 29, line 26, after "first region of DNA" delete "sequence" and insert therefore—sequences--.

In claim 29, line 26, after "second region of DNA" delete "sequence" and insert therefore—sequences--.

In claim 29, line 27, after "cassette" delete ";" and insert therefore--.--.

b) Amend the specification as follows:

At page 11, lines 6-9, delete "(e.g., as AMPLITAQ[®], by Applied Biosystems....Taq DNA polymerase gene in E. coli)" and insert therefore—(e.g., as AMPLITAQ[®])--.

At page 18, lines 27-29, delete "(e.g., as AMPLITAQ[®], by Applied Biosystems....Taq DNA polymerase gene in E. coli)" and insert therefore—(AMPLITAQ[®])--.

Substance of the interview concluding April 8, 2004

4. On March 31, 2004, the examiner contacted Applicant's representative to propose amendments that would overcome remaining issues of indefiniteness in claims 28-29 and place those claims in condition for allowance. The examiner further proposed canceling descriptive information regarding AMPLITAQ added to the specification by Applicant's amendment of February 26, 2004, as the added information was unnecessary and lacked basis in the originally filed specification. The examiner also requested clarification regarding the status of claim 23, as the claim was indicated as being canceled in Applicant's claim set but was referred to as withdrawn in Applicant's remarks. Applicant's representative confirmed that claim 23 was canceled, and indicated that he would review the examiner's proposed amendments. On April 8, 2004, Applicant's representative contacted the examiner and agreed to the proposed amendments. Claims 28-29 are therefore allowed.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 571/272-0744. The examiner can normally be reached on Monday-Friday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached at 571/272-0745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Diana B. Johannsen", with a long, sweeping horizontal line extending to the right.

Diana B. Johannsen
Patent Examiner
April 12, 2004